

### REMARKS

The Office Action indicated that Claims 3 and 9-17 would be allowable if rewritten in independent form. Applicant requests that the allowance be held in abeyance until consideration of this response. Claims 18-21 are newly added, but do not add any new matter.

The Office Action objected to the Information Disclosure Statement. Applicant has submitted an Information Disclosure Statement with this application to overcome this objection.

The Office Action objected to the drawings as not showing every feature of the invention specified in the claims. Applicant has included a replacement sheet to overcome the objection.

The Office Action objected to the specification as failing to provide proper antecedent basis for the claimed subject matter. Applicant has amended the specification as suggested by the Examiner.

The Office Action rejected Claims 1-17 under 35 U.S.C. §112 as being indefinite. Applicant has amended the claims to overcome the rejection.

The present invention results from the discovery that by using flexible limbs to accommodate joint movements in a sealing system, the effects of a moving horizontal and vertical surface can be reduced. As infrastructure such as houses and buildings have become more expensive, damages to infrastructure have also become more expensive. If the problem is left undiscovered, the infrastructure could suffer even more severe damage. This problem is accentuated by the soaring costs of labor as it takes a lot of manual labor to remove the damaged portion of the infrastructure and then to replace the damaged infrastructure with new portion of the infrastructure. Thus, consumers have demanded the most technologically advanced sealing systems possible to reduce the amount of damage to the infrastructure as any small reduction in damage would result in huge savings. Sealing systems, however, is a crowded field with many

technological advancements over the years. Therefore, any small improvement, no matter how minute can be the crucial difference between commercial viability and failure.

Thus when differences that may appear technologically minor nonetheless have a practical impact, particularly in a crowded field, the decision-maker must consider the obviousness of the new structure in this light.

*Continental Can Co. USA Inc. v. Monsanto Co.*, 20 U.S.P.Q. 2d. 1746, 1752 (Fed. Cir. 1991).

One embodiment of the present invention has an upper limb 11 having an upper limb upper boundary 12 and an upper limb lower boundary 13 between which there extends an upper limb outer face 14. The upper limb outer face 14 can be adapted through a series of ridges 15 and recesses 16 to accommodate and grip an adhesive or sealing material it may engage with such as a vertical surface A. (Pg. 5, lns. 5 – 9)

The upper limb 11 has an upper limb inner face 17 from which there extends a flexible outer limb 18. (Pg. 5, lns. 12 – 15) Upper limb 11 and outer limb 18 are semi flexible and in the event of horizontal surface B moving down, which is typically caused by acrylic bath deflection or timber floor joist shrinkage, or the vertical surface moving back, which is typically caused by timber stud wall shrinkage, the outer limb 18 will deflect substantially about the axis neck 32 because this limb is not installed under tension. The sealant 30 and the inner limb 22 are substantially free to move down with the horizontal surface B and the upper limb 11 is substantially free to move back with the vertical surface A. (Pg. 5, ln. 29 – Pg. 6, ln. 4).

The Office Action rejected Claims 1, 2, 4-6, and 8 as being anticipated by *Robinson* (GB 2,348,805).

[T]he dispositive question regarding anticipation is whether one skilled in the art would reasonably understand or infer from the prior art reference's teaching that every claim [limitation] was disclosed in that single reference.

*Dayco Prods., Inc. v. Total Containment, Inc.*, F.3d 1358, 1368 (Fed. Cir. 2003).

*Robinson* is directed towards a sealing system adapted to be used with a minimum volume of complementary sealing member. It uses a rigid first upper limb and a second outer limb adapted to engage the sealing material with a horizontal surface, and a third limb which forms a shuttering to reduce the volume of sealing material. (Abstract).

*Robinson* does not teach or suggest wherein “the longitudinal strip profile (10) is semi-flexible.” In *Robinson*, the sealing strip 10 uses a rigid first upper limb 11 as opposed to a semi-flexible longitude strip. (Abstract; Pg 1 lns. 21 – 32; Fig. 1) (emphasis added). Using a rigid upper limb, if the vertical wall moves, an increased amount of stress is placed on the upper limb either directly through the wall or vicariously through the sealing material. This could lead to the upper limb cracking or separating from the sealing material.

In contrast, in the present invention, the sealing system uses a longitudinal strip that is semi-flexible. As shown in Figures 1 and 2, upper limb 11 and outer limb 18 are semi flexible. Thus, if horizontal surface B moving down, which is typically caused by acrylic bath deflection or timber floor joist shrinkage, the outer limb 18 will deflect substantially about the axis neck 32 because this limb is not installed under tension. Likewise, in the case of the vertical surface moving back, which is typically caused by timber stud wall shrinkage, the outer limb 18 will deflect substantially about the axis neck 32 because this limb is not installed under tension. Furthermore, the sealant 30 and the inner limb 22 are substantially free to move down with the horizontal surface B and the upper limb 11 is substantially free to move back with the vertical surface A. (Pg. 5, ln. 29 – Pg. 6, ln. 4).

Furthermore, *Robinson*’s teaching of rigidity within its strips would teach away from the present invention since the present invention is directed towards accommodating joint

movements to reduce the effects of moving horizontal and vertical wall movements. A rigid upper limb would not be able to reduce the effects of moving horizontal and vertical wall movements.

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would be lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

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*Robinson* also fails to disclose wherein "the at least one second outer limb is flexible." There is no indication in *Robinson* that the second outer limb 19 is flexible. *Robinson* only discloses that the outer limb 19 is adapted to "throw off water."

However, in the present invention, the outer limb 18 is flexible. As stated above, this is advantageous because the outer limb 18 will deflect substantially about the axis neck 32 because this limb is not installed under tension.

*Robinson* also does not recite wherein there is "at least a third flexible inner limb (22) or filler material adapted to sealingly engage an uncured sealing material and to aid the full or substantial isolation of the uncured sealing material from the upper limb inner face (17) or the outer limb lower face (21)." There is no teaching in *Robinson* that the limb 25 should be flexible. *Robinson* only discloses that the first upper limb 11 should be rigid. *Robinson* only discloses that the limb 25 is used to "confine the complementary sealing material 30 (fig. 2) to a desired volume." (Pg. 5, lns. 5 - 7). This is specifically noted in the specification of the present invention. (Our Spec., Pg. 2, lns. 8-9)

*Robinson* also does not teach using the third flexible inner limb to isolate the uncured sealing material. *Robinson* only discloses using the flexible inner limb to reduce the volume of

sealing material as opposed to restricting the location of the sealing material. In contrast, in the present invention, the third flexible inner limb 22 or filler material is adapted to sealingly engage an uncured sealing material and to aid the full or substantial isolation of the uncured sealing material from the upper limb inner face 17 or the outer limb lower face 21.

Dependent Claims 2, 4-8, and 18-21 depend from and further define Claim 1 and are thus allowable, too.

It is believed that the case is now in condition, and an early notification of the same is requested.

If there are any questions with regards to the prosecution of this application, the undersigned attorney can be contacted at the listed phone number.

Very truly yours,

**SNELL & WILMER L.L.P.**



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Joseph W. Price  
Registration No. 25,124  
600 Anton Boulevard, Suite 1400  
Costa Mesa, California 92626-7689  
Phone: 714-427-7020  
Fax: 714-427-7799